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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/935,668
Filing Date: August 24, 2001
Appellant(s): NAKAMURA ET AL.

Kenneth H. Salen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Jun. 21,
2006, appealing from the Office action mailed Nov. 03, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest
is contained in the brief.

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(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1, 3-5, 7, 9-11, 13, 14, and 18-22.

Claims 2, 6, 8, 12, and 15-17 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification

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by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient for the following reasons:

(1) The brief does not refer to the specification by page and line number where the specification describes the limitation "color toner comprising at least a binder resin, a colorant and an infrared absorber" recited in claims 1, 11, 19, 20, and 22. The examiner notes that the description of said limitation is found at page 4, lines 23-24 and at page 7, lines 26-29, of the originally filed specification.

(2) The brief does not refer to the specification by page and line number where the specification describes the limitation "the toner is capable of being photofixed" recited in claims 1, 19, 20, and 22. The examiner notes that the description of said limitation is found at page 4, lines 3-6 and 25-26, of the originally filed specification.

(3) The brief incorrectly states that the method steps recited in claim 7 are described at page 17, line 14, to page 18, line 1, of the specification. The examiner notes that the description of said steps is found at page 5, lines 2-17, and at page 17, lines 6-27, of the originally filed specification.

(4) The brief incorrectly states that the apparatus components broadly recited in instant 11 are described at page 17, line 14, to page 18, line 1, of the specification. The examiner notes that the description of the apparatus components recited in instant claim 11 is found at page 5, lines 18-33, of the originally filed specification.

(5) The brief does not expressly state where Examples 2-1 to 2-5 are found in the specification. Appellants refer to said examples in claims 1, 7, 11, 19, 20, and 22, as describing the second polyester recited in those claims. The examiner notes that "Examples 2-1 to 2-5" appear to refer to the polyesters, labeled Polyester 2-1 to 2-5, listed in Table 1 at page 24 of the originally filed specification.

(The examiner notes that the citation of claim 12 at page 7 of the brief appears to be a transcription error. It appears that pending claim 14, which depends from claim 11, should have been cited. Claim 12 has been cancelled. Appellant has acknowledged the cancellation of claim 12. See the brief, at page 3, listing of pending claims on appeal, and at page 19, in the claims appendix VIII.)

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,863,824

Uchida et al.

09-1989

Whelan, T., Polymer Technology Dictionary, Chapman & Hall, NY (1994), p. 225.

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-5, 7, 9-11, 13, 14, and 18-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) Instant claim 1 and claims 3-5, which depend from claim 1, recite that the second polyester resin is a "non-crosslinked" polyester resin having a softening point Tsp of not lower than 80°C and lower than 110°C.

Instant claim 20 recites that the second polyester resin is a "linear" polyester resin having a softening point Tsp of not lower than 80°C and lower than 110°C.

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Instant claims 7 and 11, and claims dependent thereon, recite that the second polyester resin is "a polymerization product of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and terephthalic acid in the absence of a crosslinking component" and has a softening point Tsp of not lower than 80°C and lower than 110°C.

Instant claims 18 and 21, which depend on claims 1 and 20, respectively, further recite that the second polyester resin is "a polymerization product of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and terephthalic acid in the absence of a crosslinking component."

The originally filed specification does not provide an adequate written description of the second polyester resin recited in the instant claims. The specification describes only a second non-linear polyester resin having a Tsp of not lower than 80°C and lower than 110°C. See the originally filed specification, page 4, line 36, to page 5, line 1; page 8, lines 11-16 and 24-31; and page 10, lines 8-10. The term "non-crosslinked" recited in instant claim 1 is broader than the originally disclosed term "non-linear" because it includes "linear" polyester resins. The term "linear polymer" is usually

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defined as polymers that are not branched, cross-linked, or of a network structure. See Polymer Technology Dictionary, page 225. In light of the definition of the term "linear polymer," the term "non-linear polymer" thus refers to polymers that are branched, cross-linked, or of a network structure. There is no disclosure in the originally filed specification that the second non-linear polyester is a "non-crosslinked" polyester resin as broadly recited in instant claim 1. Nor is there any disclosure that the second polyester resin is a "linear" polyester resin as broadly recited in instant claim 20. Furthermore, there is no disclosure that the second polyester resin is a polymerization product obtained "in the absence of a crosslinking component" as broadly recited in the instant claims 7, 11, 18, and 21. The originally filed specification, in Table 1 at page 24, discloses only two particular polyester resins, 2-2 and 2-3, that meet the softening point T_{sp} and acid value requirements recited in claims 1, 7, 11, 18, 20, and 21. Polyester resin 2-2 is obtained by reacting 5 mol of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and 5 mol polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, a 1:1 molar ratio, with 11 mol of terephthalic acid in the presence of 2 g of dibutyltin oxide for 3 hours at 220°C and for 3 additional hours at 240°C. Polyester resin 2-3 is obtained by reacting 5 mol of polyoxypropylene

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(2.2)-2,2-bis(4-hydroxy-phenyl)propane and 5 mol polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, a 1:1 molar ratio, with 12 mol of terephthalic acid in the presence of 3 g of dibutyltin oxide for 3 hours at 220°C and for 2 additional hours at 240°C.

Resins 2-2 and 2-3 also have a Tsp of 80°C and 100°C, respectively, and an acid value of 7.5 and 10.6, respectively.

The second polyester resins recited in instant claims 1 and 20 are broader than the exemplified resins 2-2 and 2-3 because they include non-crosslinked polyesters and linear polyesters that are not related to resins 2-2 and 2-3, such as polyester resins that are obtained from other monomers, or polyesters that do not have a Tsp of 80 or 100°C, the Tsp value of resins 2-2 and 2-3, respectively, or polyesters resins that do not have the acid values of resins 2-2 and 2-3. Moreover, the second polyester resins recited in instant claims 7, 11, 18, and 21 are broader than the exemplified resins 2-2 and 2-3, because they include polyester resins that are not related to resins 2-2 and 2-3, such as, for example, polyesters that are obtained from other monomers not present in the two particular exemplified resins, or polyesters that do not have a Tsp of 80 or 100°C, the Tsp value of resins 2-2 and 2-3, respectively, or polyesters that do not comprise the acid values of resins 2-2 and 2-3. The claim language "second polyester resin being a polymerized product of

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polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and terephthalic acid in the absence of a crosslinking component" recited in instant claims 7, 11, 18, and 21 does not exclude the presence of other acid components and alcohol components that the originally filed specification teaches can be used to obtain the second polyester resin having the acid value and Tsp value recited in the instant claims. The two narrow exemplified polyester resins 2-2 and 2-3 provide an adequate written description for only those two exemplified linear, non-crosslinked polyester resins 2-2 and 2-3.

(2) Instant claim 19 recites that the second polyester resin is a "non-crosslinked" polyester resin having a softening point Tsp of 110°C.

Instant claim 22 recites that the second polyester resin is a "linear" polyester resin having a softening point Tsp of 110°C.

The originally filed specification does not provide an adequate written description of the second polyester resin recited in the instant claims. The discussion regarding the lack of an adequate written description for second "non-crosslinked" polyester resins and second "linear" polyester resins in item (1) above is incorporated herein by reference.

Furthermore, as discussed in item (1) above, the specification describes only a second non-linear polyester resin having a Tsp of "not lower than 80°C and lower than 110°C" (emphasis added). See the originally filed specification, page 4, line 36, to page 5, line 1; and page 8, lines 11-16 and 24-31. Moreover, the originally filed specification describes the disadvantages of using a second polyester resin having a Tsp of 110°C or higher. The originally filed specification at page 8, lines 26-31, discloses that "[w]hen the softening point Tsp of the polyester resin is 110°C or higher, low energy fixability is lowered" (emphasis added). The originally filed specification, in Table 1 at page 24, exemplifies only one particular polyester resin, 2-4, that meets the softening point Tsp and acid value requirements recited in claims 19 and 22. Polyester resin 2-4 is obtained by reacting 5 mol of polyoxypropylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane and 5 mol of polyoxyethylene (2.2)-2,2-bis(4-hydroxy-phenyl)propane, a 1:1 molar ratio, with 13 mol of terephthalic acid in the presence of 6 g of dibutyltin oxide for 3 hours at 220°C and for 3 additional hours at 240°C. Polyester resin 2-4 has a Tsp of 110°C and an acid value of 19.6. The second polyester resins recited in instant claims 19 and 22 are broader than the exemplified resin 2-4 because they include non-

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crosslinked polyesters and linear polyesters that are not related to polyester resin 2-4, such as polyester resins that are obtained from other monomers, or polyesters that do not have the acid value of 19.6. The single exemplified polyester resin 2-4 provides an adequate written description for only that exemplified linear, non-crosslinked polyester resin 2-4.

(10) Response to Argument

I. The rejection of claims 1, 3-5, 7, 9-11, 13, 14, and 18-22 under 35 U.S.C. 112, first paragraph, for failing to be supported by an adequate written description of the second polyester resin being "non-crosslinked" as recited in instant independent claims 1 and 19, being "non-linear" as recited in instant independent claims 20 and 22, or made in the absence of a "crosslinking component" as recited in instant independent claims 7 and 11.

Appellants assert that disclosure in the originally filed specification describing the second polyester resin as "non-linear" was an obvious error. Appellants assert that "one skilled in the art . . . would have recognized . . . that the description of the non-crosslinked polymers as 'non-linear' was an error, and would have realized that the correction would have been that the second polymer should have been referred as 'non-

crosslinked' (claims 1 and 19) or "linear (claims 20 and 22)."

Appellants submit that the Rule 132 declaration, which was executed by Masatoshi Kimura on Aug. 5, 2003, filed on Aug. 11, 2003, which is listed in the "IX. Evidence Appendix" at page 25 of brief, "indicates that the Declarant, upon reading the specification, both easily recognized that an error was apparent, and also easily recognized what the correct meaning should have been." The Rule 132 declaration bases its conclusion that the originally disclosed and claimed "non-linear" second polyester resin in the instant specification was a readily apparent error and that the correction should be "a second linear polyester" on: (1) the disclosure in the instant specification, in particular that at page 10, lines 3-25; (2) exemplified polyesters 2-1 to 2-5 of the specification; and (3) paragraph 0021 of the certified English-language translation of the priority document, Japanese Patent Application No. 2001-101159, filed on Aug. 11, 2003, which is also listed in the "IX. Evidence Appendix" at page 25 of brief.

Appellants' assertions are not persuasive. As discussed in the rejection in section (9) above, the originally filed specification only describes the second polyester resin as being "a non-linear polyester resin having a softening point Tsp of not lower than 80°C and lower than 110°C" (emphasis added). Also

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see the originally filed claims, in particular, independent claims 1, 7, and 11, where each claim requires that the second polyester resin be a "non-linear polyester resin" (emphasis added). Appellant does not indicate where in the originally filed specification there is a general description of the second polyester being "linear" or "non-crosslinked." There are only a few specific examples that exemplify second linear, non-crosslinked polyester resins having a Tsp within the Tsp range of not lower than 80°C and lower than 110°C. However, the originally filed specification at page 21, lines 7-8, expressly states that "the present invention is not limited to these Examples."

Furthermore, the Rule 132 declaration is merely conclusory. The evidence on the present record does not support the statements made by declarant for the following reasons:

(1) Contrary to declarant, the context of the disclosure regarding the "logical incongruity between the first, non-linear, polyester and the second, non-linear polyester" would not have led a person having ordinary skill in the art to recognize that the disclosed second non-linear polyester is an obvious error, and that the second polyester should have been identified as a non-crosslinked polyester resin as recited in the instant claims. As discussed in the above rejection in

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section (9), item (1) above, the originally filed specification only describes a polyester binder resin comprising a first non-linear polyester resin and a second non-linear polyester resin having a Tsp of not lower than 80°C and lower than 110°C. There is no general description that the second polyester resin is a linear polyester resin or that it is a non-crosslinked polyester as recited in the instant claims. For example, as discussed in the rejection, the originally filed specification at page 8, lines 6-8 and 11-13, describes a second non-linear polyester resin has a Tsp of not lower than 80°C and lower than 110°C. The specification at page 8, lines 17-23 and 26-31, further discloses that when the first and second polyester resins have a Tsp outside the ranges recited in instant claims 1, 7, 11, and 20, "low energy fixability" is lowered or "void resistance" is lowered. The specification at page 10, lines 3-11, discloses that "the first polyester resin is a non-linear polyester resin containing a tri- or polyvalent monomer, and also has a comparatively high molecular weight, and thus exhibits excellent void resistance, but is not easily fixed by means of low light emission energy." The specification further discloses that "[o]n the other hand, the second polyester resin is a non-linear polyester resin and can have excellent low energy fixability. However, the second polyester resin is inferior in void

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resistance because of its low viscosity" (emphasis added). The specification at page 10, lines 15-20, discloses that "when using the first and second polyester resins in combination . . . the synergy effect of merits of the first and second polyester resins can achieve excellent flash fixability without causing voids."

Declarant has not indicated what disclosed property or properties of the second non-linear polyester resin in the disclosure of the originally filed specification would have led a person having ordinary skill in the art to recognize clearly that the disclosed second polyester resin could only have been identified as a "linear" or "non-crosslinked" polyester resin. Cross-linked polyester resins having a Tsp within the range of not lower than 80°C and lower than 110°C (e.g., 95 or 100°C) and "no chloroform insolubles" are known in the toner art. See US 4,863,824 (Uchida), for example, Tables 1 and 2, polyester nos. 1-2b, 2-1, 2-2a, and 2-3. Uchida discloses that said non-linear polyester resins having a low content of trivalent or higher valency monomers, but which have a low molecular weight, ensure "ease of toner image fixing at low temperatures." Col. 3, lines 19-25. Thus, contrary to declarant, the second polyester resin could have been a non-linear polyester resin.

(2) As noted supra, the originally filed specification does limit the invention to its examples. The specification expressly states that the "present invention is not limited to" the examples. Moreover, contrary to declarant, the exemplified second resins 2-1, 2-4, and 2-5 are outside the scope of instant independent claims 1, 7, 11, and 20 because they have Tsp values of 70, 110, and 120°C, respectively, which are outside the range of "not lower than 80°C and lower than 110°C" recited in those claims. Exemplified resins 2-1, 2-2, 2-3, and 2-5 are also outside the scope of instant independent claims 19 and 21 because their Tsp values are outside the scope of a "Tsp of 110°C" recited in instant claims 19 and 22. Exemplified resins 2-1 and 2-5 are further outside the scope of instant claims 1, 7, 11, 19, 20, and 22 because the resins have an acid value of 3.5 or 30.5, respectively, which are both outside the second polyester resin acid value range of 5 to 20 recited in those claims. Furthermore, the originally filed specification labels toners "comparative" that comprise a first non-linear polyester resin as recited in the instant claims and the second resin 2-1 or 2-5. See Table 2 at page 27, polyester binder resins J and M, which comprise second polyester resin 2-1 or 2-5, respectively; and Table 4 at page 33, comparative examples 5 and 7, which comprise polyester binder resins J or M,

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respectively. As discussed in the rejection in section (9), item (1), the two narrow exemplified species of non-crosslinked polyester resins, 2-2 and 2-3, do not provide an adequate written description of said broad second non-crosslinked polyester resin or second linear polyester resin recited in instant claims 1, 7, 11, and 20. Furthermore, as discussed in the rejection in section (9), item (2), the one narrow exemplified species of non-crosslinked polyester resin 2-4 does not provide an adequate written description of said second non-crosslinked polyester resin or second linear polyester resin broadly recited in instant claims 19 and 22. A person having ordinary skill in the art would not of necessity have recognized that the two narrow exemplified species, resins 2-2 and 2-3, are representative of the entire scope of the broad second non-crosslinked or linear polyester resins recited in the instant claims 1, 7, 11, and 20. Nor would that person of necessity have recognized that the one narrow exemplified species, resin 2-4, is representative of the entire scope of the broad second non-crosslinked or linear polyester resins recited in the instant claims 19 and 22.

(3) As discussed in the rejection in section (9), item (1), the originally filed specification only describes the second polyester resin as being a "non-linear" polyester resin having a

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Tsp of not lower than 80°C and lower than 110°C. There is no disclosure of the second polyester being a non-crosslinked or linear polyester resin as broadly recited in instant claims 1, 7, 11, 19, 20, and 22. Nor is there any disclosure that the disclosed second non-linear polyester is not cross-linked.

Throughout the English-language translation of the priority document, the second polyester resin is described as a non-linear polyester, but for page 12, lines 10-12, of the translation, i.e., paragraph 0021 of the priority document. See the translation, page 1, line 17, page 2, lines 15-16, page 3, lines 6-7, page 7, lines 8-9, page 10, lines 10 and 22-24, page 38, lines 17-18, page 40, lines 1-2, and page 41, lines 9-10. Thus, contrary to declarant's comments, it is the one statement that the second polyester resin is linear, i.e., paragraph 0021 in the translation, that would appear to be in error.

In any event, the priority document is not part of the originally filed specification. The originally filed specification was not filed in the non-English language (37 CFR 1.52(d)), nor did it explicitly incorporate said priority document by reference. Appellant could not rely on the disclosure of the unincorporated foreign priority document (even if it did contain such a teaching) to provide the missing

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antecedent basis for the second "non-crosslinked" or "linear" polyester broadly recited in the instant claims. See Ex parte Bondiou, 132 USPQ 356 (Bd. App. 1961). The application must be complete when filed.

Accordingly, the Rule 132 declaration is insufficient to show that the originally filed specification description of the second polyester resin as being "non-linear" was an obvious error and that a person having ordinary skill in the art would have recognized that the correction would have been that the second polymer should have been referred as "non-crosslinked" or "linear."

Appellant further disagrees with the examiner's position that exemplified resins 2-1 to 2-5 do not provide an adequate written description of the second "non-crosslinked" or "linear" polyester resin recited in the instant claims. Appellant asserts that "all of the examples 2-1 to 2-5 . . . include second polyesters that are linear and non-crosslinked because they do not include any crosslinking agent . . . are representative of at least portions of the claimed invention, and . . . contribute to the teachings in the specification." Appellant submits that "even if one skilled in the art would have recognized only Examples 2-2 and 2-3 as supporting the entire claimed invention, one skilled in the art would by

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necessity still have looked to all of the examples in the specification, and would have confirmed from all of the examples that the description of the second polyesters as being crosslinked and/or non-linear is erroneous."

Appellant's assertions are not persuasive for the reasons discussed supra. As discussed supra, the originally filed specification generically describes a second "non-linear" polyester resin having a Tsp of "not lower than 80°C and lower than 110°C." Appellant has not indicated where in the originally filed specification there is a generic description of the second polyester being "non-crosslinked" or "linear" as recited in the instant claims. Furthermore, as noted supra, the originally filed specification expressly states that the "present invention is not limited to these Examples." The two narrow exemplified polyester resins 2-2 and 2-3 provide an adequate written description for only those two exemplified linear, non-crosslinked polyester resins 2-2 and 2-3, and not for the second polyester resins broadly recited in instant claims 1, 7, 11, and 20. The one narrow exemplified linear, non-crosslinked polyester resin 2-4, provides an adequate written description for only that exemplified resin, and not for the second polyester resins broadly recited in instant claims 19 and 22. Appellant appears to confuse a possible "obvious variation" with

an adequate written description. See, e.g., Lockwood v. American Airlines, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) ("Entitlement to a filing date does not extent to subject matter which is not disclosed but would be obvious over what is expressly disclosed. It extends only to that which is disclosed . . . The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.")

Accordingly, the examiner's rejection for lack of an adequate written description for the second polyester resin being a "non-crosslinked" resin, a "linear" resin, or made "in the absence of a crosslinking component" recited in the instant claims under 35 U.S.C. 112, first paragraph, should be affirmed.

II. The rejection of claims 19 and 22 under 35 U.S.C. 112, first paragraph, for also failing to be supported by an adequate written description of the second polyester resin recited in those claims.

Appellant asserts that the examiner is improperly ignoring the other exemplified polyesters that provide support for the

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claimed invention. Appellant asserts that "[w]hile resins 2-1 and 2-5 do not exhibit Tsp of exactly 110°C, Appellant submits that they can be seen as supporting a range of Tsp from about 70 to about 120°C. Appellant has elected to claim a resin having the exact Tsp of 110°C, rather than the entire disclosed and supported range of Tsp, but that is Appellant's right according to [In re] Wertheim."

Appellant's assertions are not persuasive. Unlike the facts in Wertheim, there is no description in the originally filed specification that the color toner of the invention comprises a second polyester having a Tsp in the range of 70 to 120°C, as urged by appellant. Rather, as discussed in the rejection in section (9), item (2) above, the originally filed specification only broadly describes a second non-linear polyester resin having a Tsp of "not lower than 80°C and lower than 110°C" (emphasis added). The language "lower than 110°C" excludes Tsp values of 110°C and higher, e.g., the Tsp values of 110°C and 120°C of second polyester resin 2-4 and 2-5, respectively. The language "not lower than 80°C" excludes Tsp values lower than 80°C, e.g., the Tsp of 70°C of second polyester resin 2-1. Furthermore, as discussed in the rejection supra, the originally filed specification describes the disadvantages of using a second polyester resin having a Tsp of 110°C or more.

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In addition, the originally filed specification at page 8, lines 28-31, describes the disadvantages when the second polyester resin has a Tsp of 80°C or lower. Moreover, the originally filed specification labels toners "comparative" that comprise a first non-linear polyester resin as recited in instant claims 19 and 22 and the second resin 2-1 or 2-5. See Table 2 at page 27, polyester binder resins J and M, which comprise second polyester resin 2-1 or 2-5, respectively; and Table 4 at page 33, comparative examples 5 and 7, which comprise polyester binder resins J or M, respectively. Accordingly, in view of the disclosure in the originally filed specification, a person having ordinary skill in the art would not have recognized that the originally filed disclosure describes appellant's invention as including a color toner comprising a second polyester resin having a Tsp in the range of "about 70 to about 120°C" as urged by appellant.

Moreover, as discussed in the rejection in section (9) above, the only description of a second polyester resin having a Tsp of 110°C in the originally filed specification is that found in exemplified second polyester resin 2-4. For the reasons discussed supra, the single exemplified species of a linear, non-crosslinked polyester resin, 2-4, does not provide an adequate written description of the "second non-crosslinked

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polyester resin" broadly recited in instant claim 19 and the "linear polyester resin" broadly recited in instant claim 22. The single exemplified polyester resin 2-4 only provides an adequate written description for only the linear, non-crosslinked polyester resin 2-4. Thus, in view of the originally filed disclosure as discussed supra, a person having ordinary skill in the art would not have recognized that the one narrow exemplified species is representative of the entire scope of the second non-crosslinked polyester resin or the second linear polyester resin broadly recited in the instant claims.

Accordingly, the examiner's rejection for lack of an adequate written description for the second polyester resin recited in instant claims 19 and 22 under 35 U.S.C. 112, first paragraph, should be affirmed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Aug. 28, 2006

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